

Application Serial No. 09/901,013
Amendment dated March 3, 2005
Reply to Office action of December 3, 2004

REMARKS

Claims 80 through 83 and 92 through 96 are pending in this application. Claims 80 and 92 are amended herein. Support for the amendments to the claims may be found in the claims as filed originally, as well as the specification at page 29, lines 8 through 18. Reconsideration of this application in view of the foregoing amendments and the following remarks is respectfully requested.

Claim Rejections - 35 U.S.C. § 112:

Claims 80 through 83 and 92 through 96 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 80 and 92 were amended to make them more definite. In particular, the preambles of claims 80 and 92 make clear that the robotic system is for moving a sample or tissue. It is submitted that it would be clear to those of skill in the art that the tissue or sample is related to the robotic system in that the robot system is for moving a sample or tissue between reaction chambers. Withdrawal of the rejection is earnestly solicited.

Claims 80 through 83 and 92 through 96 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. In particular, the Office action asserts that there is no literal support for a system of robotics in the originally filed specification, nor is there support for a plurality of robotics. The rejection is traversed.

The recitation "system of robotics" is submitted to be equivalent grammatically to the phrase "robotic system," for which there is literal support at page 29, line 7 of the specification as filed originally. Furthermore, there is no requirement that every element of a claim be supported literally by the specification. To the contrary, it is clear from the case law that the invention can be described in "words" which we believe would be accomplished by the term "robot" in the specification. Indeed, the Lilly case cited in the Office action cites Lockwood, which says as much. In Lockwood, for example,

One shows that one is "in possession" of the invention by describing the invention, with all its claimed limitations, not that which makes it obvious. Id. ("The applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed.") (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in haec verba, see Eiselstein v. Frank, 52 F.3d 1035, 1038, 34 U.S.P.Q.2D (BNA) 1467, 1470 (Fed.

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Cir. 1995) ("The prior application need not describe the claimed subject matter in exactly the same terms as used in the claims"), the specification must contain an equivalent description of the claimed subject matter. A description which renders obvious the invention for which an earlier filing date is sought is not sufficient.

Furthermore, as noted in M.P.E.P. § 2163(I), "Compliance with the written description requirement is essentially a fact-based inquiry that will 'necessarily vary depending on the nature of the invention claimed.'" Enzo Biochem, 323 F.3d at 963, 63 USPQ2d at 1613.

The cases cited in the Office action pertain, in the main, to chemistry or biology. Since, as noted above, compliance with the written description requirement will depend on the nature of the invention claimed, it is submitted that these examples hold little relevance to the level of written description necessary to support a robotic system or a system of robotics. In one case that doesn't, Moba, B.V. v. Diamond Automation, Inc., 325 F. 3d 1306, 1319, 66, U.S. P.Q2d 1429, 1438 (Fed.Cir.2003), the court found adequate written description, and asserted. "FPS's contention that the '505 patent does not adequately disclose lifting eggs from a moving conveyor merely revives its non-infringement argument in the cloak of a validity challenge. "

Furthermore, according to M.P.E.P. § 2163(I),

"There is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. In re Wertheim, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976) ("we are of the opinion that the PTO has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims"). However, as discussed in paragraph I., supra, the issue of a lack of adequate written description may arise even for an original claim when an aspect of the claimed invention has not been described with sufficient particularity such that one skilled in the art would recognize that the applicant had possession of the claimed invention. The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. For example, consider the claim "A gene comprising SEQ ID NO:1." A determination of what the claim as a whole covers may result in a conclusion that specific structures such as a promoter, a coding region, or other elements are included. Although all genes encompassed by this claim share the characteristic of comprising SEQ ID NO:1, there may be insufficient description of those specific structures (e.g., promoters, enhancers, coding regions, and other regulatory elements) which are also included."

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Here, the Office action has shown no essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of ordinary skill in the art. Robots and robotic systems are conventional in the art, as shown by the copious references describing robots submitted to the Office on October 7, 2004. Similarly, robots and robotic systems are known to one of ordinary skill in the art, as also shown by the copious references describing robots submitted to the Office on October 7, 2004. It is submitted that the mere denial that a person skilled in the art would be aware of the functions and capabilities of robots such that a description of their inner workings is necessary does not overcome the strong presumption that an adequate written description of the claimed invention is present when the application is filed.

M.P.E.P. § 2163(I)(A), in fact, advises the Office to compare Fonar Corp. v. General Electric Co., 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997) ("As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such a best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed. Thus, flow charts or source code listings are not a requirement for adequately disclosing the functions of software.").

The fact that flow charts or source code listings are *not* a requirement for adequately disclosing the functions of software, which is less concrete than robots, implies that Fig. 7 of the present application showing robots and systems thereof in schematic in conjunction with the description at page 29, lines 7-18 and the claims as filed originally are more than adequate to meet the requirements for written description.

Finally, M.P.E.P. § 2163(3)(a) states:

The description need only describe in detail that which is new or not conventional. See Hybritech v. Monoclonal Antibodies, 802 F.2d at 1384, 231 USPQ at 94; Fonar Corp. v. General Electric Co., 107 F.3d at 1549, 41 USPQ2d at 1805 (source code description not required). This is equally true whether the claimed invention is directed to a product or a process.

Robots, per se are neither new or non-conventional. The Applicants are not claiming robots per se, but rather only robots in combination with, inter alia a sample or tissue; and an

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ultrasound transducer; wherein said robot moves said sample or tissue and said ultrasound transducer from said first reaction chamber to a second reaction chamber. Therefore, it is submitted that the written description requirement has been fulfilled since the *combination* has been shown and described. Furthermore:

Patents and printed publications in the art should be relied upon to determine whether an art is mature and what the level of knowledge and skill is in the art. In most technologies which are mature, and wherein the knowledge and level of skill in the art is high, a written description question should not be raised for original claims even if the specification discloses only a method of making the invention and the function of the invention. See, e.g., In re Hayes Microcomputer Products, Inc. Patent Litigation, 982 F.2d 1527, 1534-35, 25 USPQ2d 1241, 1246 (Fed. Cir. 1992) ("One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.").

To this purpose, the Applicants have submitted references showing examples of robots known to those skilled in the art. The Applicant believes that those references may be relied upon to show that the written description requirement has been met.

Claims 80 through 83 and 92 through 96 are submitted to meet the written description requirement of 35 U.S.C. § 112, first paragraph. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 102:

Claims 80 through 83 and 92 through 96 were rejected under 35 U.S.C. § 102(e) as anticipated by Salcudean et al., U.S. Patent No. 6,425,865. The rejection is traversed to the extent it would apply to the claims as amended.

Claim 80 recites,

"said robot moves said sample or tissue and said ultrasound transducer from a first reaction chamber to a second reaction chamber."

Salcudean neither teaches, discloses, nor suggests a robot that moves a sample or tissue and an ultrasound transducer from a first reaction chamber to a second reaction

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chamber. The recitation "sample or tissue" is submitted to be definite, as discussed above, and ought to have been given patentable weight, contrary to the assertion in the Office action. Claim 80 is submitted to be allowable. Withdrawal of the rejection of claim 80 is earnestly solicited.

Claims 81, 82 and 83 depend from claim 80 and add further distinguishing elements. Claims 81, 82 and 83 are thus also submitted to be allowable. Withdrawal of the rejection of claims 81, 82 and 83 is also earnestly solicited.

Claim 92 recites,

"moving said sample or tissue and said ultrasound transducer from a first reaction chamber to a second reaction chamber."

Salcudean neither teaches, discloses, nor suggests moving said sample or tissue and said ultrasound transducer from a first reaction chamber to a second reaction chamber. The recitation "sample or tissue" is submitted to be definite, as discussed above, and ought to have been given patentable weight, contrary to the assertion in the Office action. Claim 92 is submitted to be allowable. Withdrawal of the rejection of claim 92 is earnestly solicited.

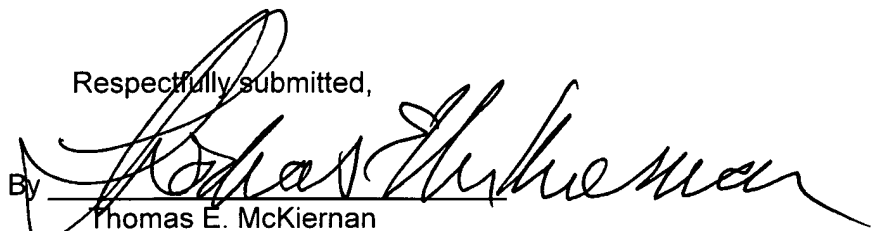
Claims 93 through 96 depend from claim 92 and add further distinguishing elements. Claims 93 through 96 are thus also submitted to be allowable. Withdrawal of the rejection of claims 93 through 96 is also earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all claims 80 through 83 and 92 through 96 are allowable. Allowance of all claims 80 through 83 and 92 through 96 and of this entire application are therefore respectfully requested.

Respectfully submitted,

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